



# UNITED STATES PATENT AND TRADEMARK OFFICE

*APV*  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/823,992

04/03/2001

Martin Green

GRE001

6426

7590

05/21/2004

DIEDERIKS & WHITELAW, PLC  
12471 Dillingham Square, #301  
Woodbridge, VA 22192

EXAMINER

SOUW, BERNARD E

ART UNIT

PAPER NUMBER

2881

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application N .

09/823,992

Applicant(s)

GREEN ET AL.

Examiner

Bernard E Souw

Art Unit

2881

--Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 35-77.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 0502a.
10. ☒ Other: Interview Summary dated 3/25/2004

## ADVISORY ACTION

### ***After-Final Response & Amendment***

1. A Request for Reconsideration filed 04/19/2004 under 37 CFR 1.116 in response to the Final Office Action dated 12/18/2003, has been received.

2. The amendment filed 04/19/2004 under 37 CFR 1.116 in reply to the final rejection has been considered, including a proposed cancellation of claims 35-54, but will not be entered because: The proposed amendment (i.e., cancellation of claims 35-54) is not deemed to place the application in better form for appeal by materially simplifying the issues for appeal.

3. Applicant's Amendment filed 04/19/2004 under 37 CFR 1.116 in reply to the final rejection dated 12/18/2003 will be entered upon the filing of an appeal, but is not deemed to place the application in condition for allowance. Upon the filing of an appeal and entry of the amendment, the status of the claims would be as follows:

**Rejected claim(s): 35-77**

4. Applicant's arguments filed 04/19/2004 along with the Request for Reconsideration under 37 CFR 1.116 have been fully considered, but they are not persuasive.

Art Unit: 2881

- ▶ The proposed cancellation of previously rejected claims 35-54 would not make the claimed invention be allowable, because the previous rejections of claims 55-57 remain in force.
- ▶ Applicant's argument brought up during the Personal Interview conducted March 25, 2004 (see attached Interview Summary), i.e., regarding the addition of the word "*predetermined*" in front of the wording "*particular mass range .... are saturating or approaching saturation*", would have been exclusively applicable to claims 35 and 54, which are proposed to be cancelled per Applicant's After Final Amendment dated 04/19/2004. However, claims 55 and 57, which remain unamended and have been previously rejected as being unpatentable over Yano et al. (USPAT 5,747,800) in view of Gregory et al. (WO 98/50941), stand rejected. In this regard, the limitation of regularly switching back and forth between the first high sensitivity mode and the second low sensitivity mode has been previously rejected as being a mere matter of design choice that does not alter the functional conditions of the device or method, and furthermore, involves only routine skill in the art, and is therefore unpatentable. Support and evidence for this Examiner's judgment is here provided, e.g., by Weinberger (USPAT 6,294,790) reciting in Col.13/ll.65-67 and Col.14/ll.1-4 the wording "*The forward trajectory SCPG detector can be automatically toggled between high resolution and high molecular weight/enhanced sensitivity modes by providing electronic or mechanical switching or voltage generation means to alter the aforementioned potentials depending upon desired mode of operation*", wherein the wording "*toggled ... by ... switching*" is understood in the art as being the

Art Unit: 2881

same as Applicant's "*switching back and forth*", whereas the wording "*depending upon desired mode of operation*" is understood in the art as being the same as "*mere matter of design choice*" brought up the Examiner.

### **CONCLUSION**

For the reasons stated above, claims 35-77 are held prima facie obvious over the cited prior arts for reasons of record.

Applicant is advised to abandon the present application altogether, and submit a completely new application with mass spectrometer/analyzer and detector as new subject matters of Applicant's invention.

### **Communications**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard E Souw whose telephone number is 571 272 2482. The examiner can normally be reached on Monday thru Friday, 9:00 am to 5:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R Lee can be reached on 571 272 2477. The central fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications as well as for After Final communications.

Art Unit: 2881

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.

bes  
May 03, 2004



JOHN R. LEE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800